



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,219	07/14/2000	Timothy B. Demers	42472.1	7012

22859 7590 08/12/2003

INTELLECTUAL PROPERTY GROUP  
FREDRIKSON & BYRON, P.A.  
4000 PILLSBURY CENTER  
200 SOUTH SIXTH STREET  
MINNEAPOLIS, MN 55402

EXAMINER

PHAN, TAM T

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/616,219		DEMERS ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Tam (Jenny) Phan		2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/13/2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Priority***

1. No priority claims have been made.
2. The effective filing date of the claimed invention is July 14, 2000.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 1-3 and 8 are generally narrative and indefinite, failing to conform with current U.S. practice. They are replete with grammatical and idiomatic errors. Claim 1 reads "the program comprising a recording medium readable by the computer and means on the recording medium". Such sentences are causing difficulty for the examiner to interpret the claimed invention. Accordingly, "the program comprising a recording medium readable by the computer, and means on the recording medium" read in claim 1 will not be given weight beyond software enablement.
6. In addition, claims 1-3 and 8 used "the internet" to mean the World Wide Web. The correct terminology is "the Internet" not "the internet".
7. Claim 6 is indefinite because it simultaneously covers two statutory classes (a computer program and article of manufacture) - an improper hybrid claim (In Ex Parte Lyell 17USPQ2d 1548 Bd.PA871990).

8. Claim 7 is indefinite because it simultaneously covers two statutory classes (a computer program and a system) - an improper hybrid claim (In Ex Parte Lyell 17USPQ2d 1548 Bd.PA871990).

9. Claim 8 is indefinite because it simultaneously covers two statutory classes (a computer program and method) - an improper hybrid claim (In Ex Parte Lyell 17USPQ2d 1548 Bd.PA871990).

10. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. For examining purposes, these claims will be treated as independent claims.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-2, 4, and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Shoff et al. (U.S. Patent No. 6,240,555), hereinafter referred to as Shoff.

12. Regarding claim 1, Shoff disclosed a computer program for controlling a computer, [and] for providing both a multimedia player component and an integrated internet browser component, wherein the program permits a user to play one or more items of multimedia and to access the internet in an integrated fashion (Title, Column 1 lines 47-51 and lines 57-63).

13. Regarding claim 2, Shoff disclosed said access of the internet is provided in the form of access to a dedicated and/or affiliated server sites adapted to provide related content (Figure 4, column 7 lines 26-35).
14. Regarding claim 4, Shoff disclosed a computer program further comprising one or more items of multimedia content (column 1 lines 47-51).
15. Regarding claim 6, Shoff disclosed an article or manufacture for use in a computer, comprising a digital recording medium [CD-ROM] comprising an application (column 1 lines 46-51).
16. Regarding claim 7, Shoff disclosed a system comprising a computer program in combination with a dedicated server adapted to be linked by the browser in order to provide related content (column 5 lines 23-26, column 8 lines 47-55).
17. Regarding claim 8, Shoff disclosed a method of providing multimedia, the method comprising the steps of providing a computer program, loading the computer program on a client computer (column 8 lines 35-41), establishing a connection between the internet and the client computer (Figure 4, column 7 lines 26-34), and employing the program to both play one or more items of multimedia content and access the Internet for related content (column 1 lines 38-41, lines 57-63).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff as applied above in view of Fidelibus et al. (U.S. Patent Number 5,931,906), hereinafter referred to as Fidelibus, and further in view of what would have been obvious to one of ordinary skill in the art at the time of the invention.

20. Regarding claim 3, Shoff disclosed a computer program for controlling a computer, [and] for providing both a multimedia player component and an integrated internet browser component, wherein the program permits a user to play one or more items of multimedia and to access the internet in an integrated fashion (Title, Column 1 lines 47-51 and lines 57-63). Shoff further disclosed access of the internet is provided in the form of access to a dedicated and/or affiliated server sites adapted to provide related content (Figure 4, column 7 lines 26-35). Shoff did not disclose access to the Internet, which further comprises a conventional browser in order to provide access to unaffiliated server sites. However, in an analogous art, Fidelibus disclosed means for user to access the Internet to surf other features of the Web site (column 8 lines 9-18).

21. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include a conventional browser in order to provide access to unaffiliated server sites in order to give users more flexibility. This feature will allow users to enjoy the multimedia component and its supplemental content while able to access the Internet for further user actions such as view credit card statement, pay bills, etc. (column 8 lines 21-24).

22. Regarding claim 5, Fidelibus disclosed a computer program wherein the multimedia content is selected from music and corresponding video and graphics (column 2 lines 57-64).

Art Unit: 2142

23. Since all the limitations of the claimed invention were disclosed by the combination of Shoff and Fidelibus, claims 3 and 5 are rejected.

**Conclusion**

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on 703-305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

**MARC THOMPSON**

Marc Thompson  
Patent Examiner  
Art Unit 2142  
703-308-6750

tp  
August 7, 2003